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10/614,142	07/07/2003	Dennis Finch	P03-234-FIN	9025

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EXAMINER

KAVANAUGH, JOHN T

ART UNIT PAPER NUMBER

3728

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/614,142	Applicant(s) FINCH, DENNIS	
	Examiner Ted Kavanaugh	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of species II (figures 5-8) and Species IV (figures 7a-7e) in the reply filed on Oct. 12, 2004 is acknowledged.

The original species was as follows

Pointe Shoe

Species I: figures 3-4

Species II: figures 5,8

Species III: figure 10

Lock Axis Joint

Species IV: figures 6A-6E

Species V: figures 7A-7E.

But upon further review (species I and II have been joined) it has been grouped as follows:

Pointe Shoe

Species II: figures 3-5,8

Species III: figures 10

Lock Axis Joint

Species IV: figures 6A-6E

Species V: figures 7A-7E.

Therefore, the embodiment drawn to figures 3-5,7A-7E and 8 will be examined.

2. Claims 3,9-12 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Oct. 12, 2004.

Specification

3. The disclosure is objected to because of the following informalities: On Page 6, line 13, "traps" would appear it should be "straps". Element 26 is labeled "opening" at the bottom of page 6 and a "base cone" on the bottom of page 7. Element 50 has been labeled a top cup and a toe box. Which is it? Consistent terminology should be used throughout the disclosure.

Appropriate correction is required.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "37" and "31" have both been used to designate an arch plate. Elements "50", and "81" have been used to designate a toe cup. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in

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the next Office action. Also, element "27" is not found in the figures. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "26" has been used to designate both a base opening and base cone. Reference character "101" has been used to designate both a complex part and a mid-foot". Reference character "103" has been used to designate both a heel support and a heel loop. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "the plurality of liners comprising a sense shaping material, cushioning material, an inner liner for ease of ingress and egress and an inner non-slip liner for stabilizing the shoe position when secured to the foot", claim 14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claims 1-2,4-8,13-17 are objected to because of the following informalities: In claim 1, "unite" appears to be a misspelling. In claim 2, "ventricle" appears to be a misspelling. In claim 6, "sloe" appears to be a misspelling. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. Claims 1-2,4-8,13-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following phrase(s)/term(s) “means to secure it to the foot”, claim 1; “mounting means”, claim 2; “means to maintain”, claim 2 and “securing means”, claim 15 and all other terms which are followed by the word “means”, is/are indefinite because the element(s) or step(s) is/are not defined in the specification by corresponding structure, material or acts and equivalents thereof, see 35 USC 112, sixth paragraph, and therefore it is not clear what is meant by that language. A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase “means for ” or “step for ”;
- (B) the “means for ” or “step for ” must be modified by functional language; and
- (C) the phrase “means for ” or “step for ” must not be modified by structure, material or acts for achieving the specified function. Applicant fails to have the first two steps of the 3-prong analysis.

Therefore, the examiner is unable to determine what structure or equivalent structure is encompassed by such language. Since there is no corresponding structure, etc. in the specification to define the means or step plus function limitation, an equivalent will be deemed to be any element that is capable of performing the specified function. . “[Sixth paragraph of 35 U.S.C. 112] was intended to permit the use of means

expressions without recitation of all the possible means that might be used in a claimed apparatus. The price that must be paid for use of the convenience is limitation of the claim to the means specified in the written description and equivalents thereof.” O.I. Corp. v. Tekmar Co., 42 USPQ2d 17777, 1782 (Fed. Cir. 1997).

If applicant wishes to properly invoke 35 U.S.C., 6th paragraph, applicant must:

- comply with the 3-prong analysis
- show why the claim language properly invokes 35 U.S.C. 112, 6th
- identify the function (part of the 3-prong analysis)
- amend the specification to **explicitly** state what structure corresponds to the recited function with reference to the claimed terms and phrases, provided no new matter is introduced. (e.g. means for fastening includes one of the following equivalent structures: hook and loop type material, a buckle and snaps, and buttons).

Throughout the claims the term “said mid-foot segment” and “the rigid mid-foot segment” lacks proper antecedent basis and is therefore indefinite. It would appear applicant is referring back to the “mid-foot element”.

In claim 7, “a short shank” is unclear and indefinite because the invention doesn’t appear to have a shank. There is none described in the description or shown in the figures, other than the prior art figure 1, and see page 6, lines 20-23. This invention would appear not to have a rigid shank.

Claim 6 appears to be inaccurate inasmuch as the top box (50) doesn’t have a “sloe or straps”.

Claim 16 is unclear and indefinite since there doesn't appear to be any buckle mounted to the toe box (50) and therefore the scope of the claim is unclear.

Claim 14 is unclear and indefinite. As noted in the drawing objection above the combination of all these features has not been shown in the figures. Moreover, it is not clear which element is above or below the other, or what portion of the shoe these elements are located. Therefore the scope of the claim cannot be determined.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1,2,4-8,13,15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5572806 (Osawa).

Regarding independent claim 1:

Osawa teaches a boot having structure as claimed including a rigid mid-foot element (6), means to secure it to the foot (strap and buckles 10), a rigid toe loop (4 and/or 7) and a transverse joint (24-29 best shown in figures 4 and 7) mounting the mid-foot element and the toe loop.

Regarding independent claim 2:

Osawa teaches a boot having structure as claimed including a rigid conical form (6), a toe box (4,7) having a U-shaped toe loop (7; see figure 4 showing the element 7 having a u-shape (i.e. Ear pieces 24 form the upper legs of the "U")) and a transverse

rotational mounting means (24-29 best shown in figures 4 and 7) mounting the conical form to the toe box.

Regarding the remaining claims:

The front of the toe box has a flat front surface as shown throughout the figures. An inner liner represented by inner layer 12. Regarding claim 7, rigid sole 8 represents the short shank. Regarding claim 13, Osawa teaches a control plate (21), a spring (coil spring 19) and a guide and pin (link 16).

Regarding the functional claim language, inasmuch as Osawa has all the structure as claimed it would inherently be capable of performing the functional language as claimed.

11. Claims 1,2,7-8, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by US 1528265 (Roa).

Regarding independent claim 1:

Roa teaches a shoe having structure as claimed including a rigid mid-foot element (11), means to secure it to the foot (shoelace and eyelets are not shown but they are conventionally used in the art to secure the shoes), a rigid toe loop (12) and a transverse joint (see figures 3-4) mounting the mid-foot element and the toe loop.

Regarding independent claim 2:

Roa teaches a shoe having structure as claimed including a rigid conical form (11), a toe box (12) and a transverse rotational mounting means (see figures 3-4) mounting the conical form to the toe box.

Regarding the remaining claims:

An inner liner is taught at page 2, lines 8-11. Regarding claim 7, rigid sole 15 represents the short shank.

Regarding the functional claim language, inasmuch as Roa has all the structure as claimed it would inherently be capable of performing the functional language as claimed.

Conclusion

12. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

--“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”


-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

Telephone inquiries regarding other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners" M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached from 6AM - 4PM. Starting November 8th, 2004 the examiner's telephone number will change to (571) 272-4556.


Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
October 26, 2004